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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,159	08/19/1999	DAVID L. PATTON	79770F-P	8786

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PATENT LEGAL STAFF
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EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/378,159

Applicant(s)

PATTON ET AL.

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1 - 4, 6 - 26 and 28 - 55.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 6 - 26 and 28 - 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is in reference to the response to the office action mailed on 23 May 2002 received by the office on 30 September 2002. Cancellation of claims 5 and 27, Amendments to specification and claims 1, 4, 6, 7, 13 – 15, 19, 23, 24, 26, 29, 32, 33, 39, 40, 42, 43, 45, 46, 48, 49, 52, 54 and 55 are acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 23, 26 – 27, 32 – 50, 52 and 54 – 55 are rejected under 35 U.S.C. 102(e) as being unpatentable over Kara, U.S. Patent 5,819,240 hereinafter known as Kara1 in view of Brasington et al. US Patent 5,923,406 hereinafter known as Brasington and in further view of an article from Glen Stephens hereinafter known as Stephens.

Regarding claims 1, 32, 42 and 49 – 50, 52, 54 – 55 Kara1 discloses "A system and method for printing a postage meter stamp, including a desired postage amount

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and a personalized postage indicia, onto a piece of mail", and, "the user is also able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail." User takes a postal storage device to the Post Office in order to obtain a replenishment of the amount of postage stored within the postage storage device. A desired amount of postage is entered into the storage device by a postal employee through a processor-based system. The desired amount of postage is printed as a meter stamp and may contain encrypted information for security purposes or may be customized as desired by the user. In addition, Kara1 discloses that the postage storage device can be coupled to processor-based systems to receive and retrieve an amount of authorized postage and the printing of personalized postage indicia.

Also, Kara1 discloses to requests input from the user on the amount of desired postage and the configuration of the desired postage indicia and subsequently prints on an envelope, a letter or a label through a printer, or a special purpose label-maker, coupled to the PC the desired postage indicia designating the appropriate amount of postage. The user can construct his/her own design using any of the well-known drawing programs, such as, for example, Macromedia's FreeHand program, or the user can select from an established data base of graphics, either self-designed or obtained from either the post office on the portable postage memory or from other graphics suppliers via diskette data loaded into a general application program running on the PC (col. 3, lines 13 – 41).

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Kara1 does not disclose ordering of personalized postal stamps. Brasington discloses a vending machine system for printing postage stamps, the vending machine system includes an enclosed housing having a front panel with an aperture therein; a camera, mounted in the housing, for receiving through the aperture an image of at least one person and for creating an electronic image of the at least one person based on the received image of the at least one person; a printer; a payment receiving device for accepting payment and for providing a payment signal indicative that payment has been made; a computer including a memory, the computer 1) causing the camera to create the electronic image of the at least one person upon receipt of the payment signal, 2) saving the electronic image of the at least one person in the memory, and 3) utilizing the electronic image of the at least one person for controlling the printer to print a first personalized postage stamp on a recording medium, the first personalized postage stamp including predetermined data required by a postal authority and a picture of the at least one person based on the stored electronic image (abstract). In addition, Brackney discloses about "Criteria for Stamp Subject Selection" guidelines in selecting subjects which are eligible to appear on U.S. postage stamps. Therefore, it is known at the time of invention to a person with ordinary skill in the art to vendor products to non subscribing customers to permit a consumer to obtain a postage stamp which can be personally customized in appearance by the consumer, and a premium could be charged for such a stamp to create additional revenue for the postal service.

In addition, Stephens discloses that at Australia 99 World Stamp Expo March 19 – 24 (open to public) collectors were invited to use one of the 4 cameras. Images were

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printed upon conventionally pre-printed and perforated gummed stamps. Cost was about \$10 for each personalized sheet of 10 45 cents stamps. Stephens states that Australia Post handed instructions with the notation which read "Anyone deliberately making inappropriate gestures during photography will automatically forfeit their order and a refund will not be provided" (Australia Post approving the image prior to providing the stamp to the customer). Therefore, it is known at the time of invention to a person with ordinary skill in the art that personalized postage stamps with photograph was a known technology available to public for making personalized postage stamps. Also, it is known at the time of invention to a person with ordinary skill in the art that contents of the postal stamps are approved and the customer is notified whether their personalized image for the stamp is approved or disapproved. Therefore it is known at the time of invention to a person with ordinary skill in the art that postal stamps can be personalized and postal authority can control the content of the stamps to generate additional revenue by charging extra for the personalized stamps and control the content printed on the personalized stamp.

Regarding claims 2 and 3, Kara1 discloses a processor-based system where a user may invoke the system to access and retrieve a portion of the stored amount of postage via a program stored on a processor-based system, such program hereinafter referred to as the "E-STAMP" program. System is a general purpose computer, such as

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an IBM compatible (or Apple Macintosh). System includes processor (CPU), disk drive, network interface card (NIC) coupled to computer network etc.

Regarding claims 4 and 6, Kara1 discloses that the user is able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail. User can import personalized, or customized, postage indicia graphics into the interface program which allows a CPU to read a portable memory device, and to print this customized indicia on a piece of mail. In addition Kara1 discloses information on how a user may change, add a new indicia, or otherwise select which indicia is desired for a given piece of mail.

Kara1 does not disclose to print customized stamps. However, Kara1 discloses to requests input from the user on the amount of desired postage and the configuration of the desired postage indicia and subsequently prints on an envelope, a letter or a label through a printer, or a special purpose label-maker, coupled to the PC the desired postage indicia designating the appropriate amount of postage. The user can construct his/her own design using any of the well-known drawing programs, such as, for example, Macromedia's FreeHand program, or the user can select from an established data base of graphics, either self-designed or obtained from either the post office on the portable postage memory or from other graphics suppliers via diskette data loaded into a general application program running on the PC (col. 3, lines 13 – 41). Brasington discloses a vending machine system for printing personalized postage stamp including

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predetermined data required by a postal authority and a picture of the at least one person based on the stored electronic image (abstract). Therefore, it is known at the time of invention to a person with ordinary skill in the art to print customized stamps to permit a consumer to obtain a postage stamp which can be personally customized in appearance by the consumer, and a premium could be charged for such a stamp to create additional revenue for the postal service.

Regarding claims 7 – 14, 38, 45 and 48, Kara1 discloses to provide a menu of postage indicia that can be selected by the customer for particular occasions. The user is able to create or select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail. User can also personalize postage indicia. In addition, the user is provided with a message box to allow the user to add an optional message or greeting (e.g., "Happy Holidays") to be printed next to the meter stamp. This message may be changed at any time by the user, directly or by a "merge" command in conjunction with a word processing or graphics program coupled to the E-STAMP program.

Although Kara1 does not disclose modifying the shape, size, color, or orientation of the said image, it is obvious that when a user modifies an image, they modify the image to their desire, and, within the guidelines of the servicing business (for example, within the guidelines of the post office).

Also, Kara1 does not disclose uploading custom image (to central authorizing computer), However, Kara1 does disclose the system and method for printing postage meter stamp, including a desired postage amount and a personalized postage indicia, onto a piece of mail. Therefore, it is obvious that Kara1 system and method is approved by the Postal Authority (for postal products) before it is made available for use to the general public.

Kara1 does not disclose to print customized stamps. However, Kara1 discloses to requests input from the user on the amount of desired postage and the configuration of the desired postage indicia and subsequently prints on an envelope, a letter or a label through a printer, or a special purpose label-maker, coupled to the PC the desired postage indicia designating the appropriate amount of postage. The user can construct his/her own design using any of the well-known drawing programs, such as, for example, Macromedia's FreeHand program, or the user can select from an established data base of graphics, either self-designed or obtained from either the post office on the portable postage memory or from other graphics suppliers via diskette data loaded into a general application program running on the PC (col. 3, lines 13 – 41). Brasington discloses a vending machine system for printing personalized postage stamp including predetermined data required by a postal authority and a picture of the at least one person based on the stored electronic image (abstract). Therefore, it is known at the time of invention to a person with ordinary skill in the art to print customized stamps to permit a consumer to obtain a postage stamp which can be personally customized in

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appearance by the consumer, and a premium could be charged for such a stamp to create additional revenue for the postal service.

Regarding claims 15 – 16, Kara1 discloses a portable postage storage device that can be coupled to processor-based systems to receive and retrieve an amount of authorized postage and the printing of a personalized postage indicia. Under the control of a general purpose computer, it automatically calculates the amount of postage due for a particular piece of mail and imprinting that amount of postage in a personalized configuration of a meter stamp on an item of mail.

Kara1 does not disclose to print customized stamps. However, Kara1 discloses to requests input from the user on the amount of desired postage and the configuration of the desired postage indicia and subsequently prints on an envelope, a letter or a label through a printer, or a special purpose label-maker, coupled to the PC the desired postage indicia designating the appropriate amount of postage. The user can construct his/her own design using any of the well-known drawing programs, such as, for example, Macromedia's FreeHand program, or the user can select from an established data base of graphics, either self-designed or obtained from either the post office on the portable postage memory or from other graphics suppliers via diskette data loaded into a general application program running on the PC (col. 3, lines 13 – 41). Brasington discloses a vending machine system for printing personalized postage stamp including predetermined data required by a postal authority and a picture of the at least one

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person based on the stored electronic image (abstract). Therefore, it is known at the time of invention to a person with ordinary skill in the art to print customized stamps to permit a consumer to obtain a postage stamp which can be personally customized in appearance by the consumer, and a premium could be charged for such a stamp to create additional revenue for the postal service.

Regarding claims 24 and 25, neither Kara1 nor Brasington disclose notifying whether the submitted custom postage has been authorized. However, Kara1 discloses that users can select type of indicia from the menu for customization. In addition, Stephens discloses that at Australia 99 World Stamp Expo March 19 – 24 (open to public) collectors were invited to use one of the 4 cameras. Images were printed upon conventionally pre-printed and perforated gummed stamps. Cost was about \$10 for each personalized sheet of 10 45 cents stamps. Stephens states that Australia Post handed instructions with the notation which read “Anyone deliberately making inappropriate gestures during photography will automatically forfeit their order and a refund will not be provided” (Australia Post approving the image prior to providing the stamp to the customer). Therefore, it is known at the time of invention to a person with ordinary skill in the art that personalized postage stamps with photograph was a known technology available to public for making personalized postage stamps. Also, it is known at the time of invention to a person with ordinary skill in the art that contents of the postal stamps are approved and the customer is notified whether their personalized

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image for the stamp is approved or disapproved. Therefore it is known at the time of invention to a person with ordinary skill in the art that postal stamps can be personalized and postal authority can control the content of the stamps to generate additional revenue by charging extra for the personalized stamps and control the content printed on the personalized stamp.

Regarding claim 26, Kara1 discloses system and method, under the control of a general purpose computer, for automatically calculating the amount of postage due for a particular piece of mail and imprinting that amount of postage in a personalized configuration of a meter stamp on an item of mail.

Regarding claims 37 and 47, Kara1 discloses that when the user clicks on the desired indicia and then has the option of personalizing the indicia. The indicia may be personalized with information such as the name of the person, birthday that person is celebrating etc. Once an insignia has been created that the user likes, the selected indicia (with personalization) will be printed as part of the postage meter stamp on a piece of mail. The user may then choose to add the personalized selected indicia to the program or to delete it

Regarding claims 54 and 55, Kara1 discloses "A system and method for printing a postage meter stamp, including a desired postage amount and a personalized postage indicia, onto a piece of mail", and, "the user is also able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail." A user takes a postal storage device to the Post Office in order to obtain a replenishment of the amount of postage stored within the postage storage device. A desired amount of postage is entered into the storage device by a postal employee through a processor-based system. The desired amount of postage is printed as a meter stamp and may contain encrypted information for security purposes or may be customized as desired by the user. In addition, Kara1 discloses that the postage storage device can be coupled to processor-based systems to receive and retrieve an amount of authorized postage and the printing of a personalized postage indicia.

Also, Kara1 discloses that the user is able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail. User can import personalized, or customized, postage indicia graphics into the interface program which allows a CPU to read a portable memory device, and to print this customized indicia on a piece of mail.

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Claims 17 – 23, 33 – 36, 39 – 41, 43 – 44 and 46 are rejected under 35 U.S.C. 102(e) as being unpatentable over Kara, U.S. Patent 5,819,240 hereinafter known as Kara1 in view of Brasington et al. US Patent 5,923,406 hereinafter known as Brasington and in further view of an article from Glen Stephens hereinafter known as Stephens and Kara US Patent 5,717,597 hereinafter known as Kara2.

Regarding claims 17 – 23, 33 – 36, 39 – 41, 43 – 44 and 46, Kara1 discloses a system and method for printing a postage meter stamp, including a desired postage amount and a personalized postage indicia, onto a piece of mail. A user takes a postal storage device to the Post Office in order to obtain a replenishment of the amount of postage stored within the postage storage device, or, the user may also call a number (an authorized Post Office telephone number) and have the Post Office transfer the required amount of postage by modem. Also, Kara1 discloses a registration form which requires users to provide their name, address, phone mail etc.

Kara1 does not disclose electronic order form. Kara2 discloses that the POSTAGEMAKER program operates to allow the authorized refilling of the portable postage device remotely, such as, for example, through a public switched network (PSN) or LAN. (For example, the program may initiate communications with the POSTAGEMAKER program through the use of modems and telecommunications lines, upon establishing communications, the program may request an amount of postage to be replenished and indicate payment by such means as a valid bank card or a debit account maintained with the postal authority.) It is obvious at the time of applicant's

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invention to a person with ordinary skill in the art to include remote refilling to avoid user taking the device physically to the post office to replenish.

Also Kara1 does not disclose providing a receipt. Kara1 does disclose that, the amount and a conglomeration of encrypted data known as a security packet are sent to be decoded and validated, and, if all appears to be valid, perform the credit operation. If the response is acceptable, a receipt is printed out for the user and the results are written in a transaction log. Kara1 does not disclose receipt to include facsimile of the image to be used on the custom postage. It is inherent that the receipt can be in the form of facsimile, email, printed on user's system printer, mail etc. It is known at the time of applicant's invention to a person with ordinary skill in the art to provide/print a receipt for the user to make replenishment of postal storage device a legal transaction and also to avoid user disputes.

Kara1 does not disclose to print customized stamps. However, Kara1 discloses to requests input from the user on the amount of desired postage and the configuration of the desired postage indicia and subsequently prints on an envelope, a letter or a label through a printer, or a special purpose label-maker, coupled to the PC the desired postage indicia designating the appropriate amount of postage. The user can construct his/her own design using any of the well-known drawing programs, such as, for example, Macromedia's FreeHand program, or the user can select from an established data base of graphics, either self-designed or obtained from either the post office on the portable postage memory or from other graphics suppliers via diskette data loaded into a general application program running on the PC (col. 3, lines 13 – 41). Brasington

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discloses a vending machine system for printing personalized postage stamp including predetermined data required by a postal authority and a picture of the at least one person based on the stored electronic image (abstract). Therefore, it is known at the time of invention to a person with ordinary skill in the art to print customized stamps to permit a consumer to obtain a postage stamp which can be personally customized in appearance by the consumer, and a premium could be charged for such a stamp to create additional revenue for the postal service.

Claims 28 – 31 and 51 are rejected under 35 U.S.C. 102(e) as being unpatentable over Kara, U.S. Patent 5,819,240 hereinafter known as Kara1 in view of Brasington et al. US Patent 5,923,406 hereinafter known as Brasington and in further view of an article from Glen Stephens hereinafter known as Stephens and Kara US Patent 5,812,991 hereinafter known as Kara4.

Regarding claim 28 – 31 and 51, kara4 discloses that the user may change the indicia, add a new indicia, or otherwise select which indicia is desired for a given piece of mail. The user has the option of personalizing the indicia. Once an insignia has been created that the user likes, the selected indicia will be printed as part of the postage meter stamp on a piece of mail. Kara1 does not disclose to have limit for manipulating the image. However, it is known at the time of invention to a person with ordinary skill in

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the art that authorizing authority allows design changes within the guidelines of the agency. Thus, it would have been obvious to include the limit for manipulating the image to meet the guidelines of the authorizing postal authority and prevent un-appropriate images printed on the postage stamps.

Claims 52 and 53 are rejected 35 USC 103(a) as being unpatentable over Kara, U.S. Patent 5,819,240 hereinafter known as Kara1 in view of Brasington et al. US Patent 5,923,406 hereinafter known as Brasington and in further view of an article from Glen Stephens hereinafter known as Stephens and Mold US Patent 5,978,772.

Regarding claim 53, neither Kara1 nor Brasington disclose printing barcode on the receipt. However, Mold discloses a receipt with the barcode printed on a receipt. Therefore, it is known at the time of invention to a person with ordinary skill in the art to print barcode on the receipt to expedite the sales process by minimizing the customer service representative or the customer to manually enter the order number for checking the status, picking up the order etc.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

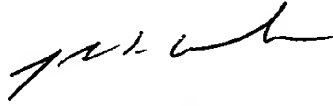
1. Personalized Postage Stamp Coming Soon
2. Can Your Picture It? Canada Post Presents Picture Postage
3. Criteria For Stamp Subject Selection
4. Design A Postage Stamp For Black History Month
5. Regal / MDC Announces E-commerce Initiative
6. Las Vegas Platinum
7. NextCard Go Shopping
8. NextCard Internet Visa And Kodak Picture CD Help Consumers Personalize Their Plastic

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

December 16, 2002



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600